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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,436	07/21/2003	Gerardo Castillo	PROTEO.P18D1	9263

7590 02/28/2007

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EXAMINER	
TATE, CHRISTOPHER ROBIN	
ART UNIT	PAPER NUMBER
1655	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/624,436	CASTILLO ET AL.	
	Examiner	Art Unit	
	Christopher R. Tate	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19,21,23-31 and 33-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19,21,23-31 and 33-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *0207*.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The amendment filed 22 December 2006 is acknowledged and has been entered. Claims 19, 21, 23-31, and 33-49 have been examined on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19, 21, 23-31, and 33-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As drafted, claims 19, 21, 23-31, and 33-49 are rendered vague and indefinite because they still do not adequately define certain limitations therein. For clarity and to hasten prosecution, it is suggested that the following changes be made to the claims:

- It is suggested that the phrase "A composition" (line 1 of independent claims 19, 23, 39, and 49) be expanded to recite --An *Uncaria* extract composition--.

- In claim 25, it is also suggested that the phrase "a composition" (line 4) be expanded to recite --an *Uncaria* extract composition--.

- It is suggested that claim 21 be amended so as to properly define a multiple dependent claim - e.g., by reciting --The composition according to claims 39, 43, 44, 47 or 48--.

- In claims 24 and 25, it is suggested that the phrase --in need thereof-- replace the phrase "susceptible to, or afflicted by, the amyloidosis or alpha synuclein disease" (especially since this claimed phrase could still be interpreted as being drawn to some type of preventative language).

- Based upon the discussion immediately above, it is also suggested that claims 26, 28, and 35 be cancelled.

- As instantly drafted, numerous claims including claims 27, 35, and 36-37 are multiple dependent claims which depend from other multiple dependent claims, which is improper. These claims should be amended accordingly.

- In claim 29, it is suggested that the phrase --in need thereof-- follow the term "subject" in line 3.

- In claim 31, it is suggested that the phrase --a therapeutically effective amount of-- be inserted before the term "any" (in line 2); that the phrase "the therapeutic amount" (line 4) be expanded to recite --wherein the therapeutically effective amount--; and that the phrase "selected for efficacy in" (line 4) be replaced with --is effective for--.

- It is suggested in claim 39, that step (q) be amended to more clearly define this final step - e.g., that the recitations of "fraction" be omitted since step (q) already recited "separating and collecting the fractions'; and also that the phrase --, whereby the Uncaria extract composition comprises one or more of said fractions-- (or similar phraseology) be inserted following step (q).

- In claims 41-48, at line 1 of each, it is suggested that the comma within the phrase "The composition of claim ... wherein, " be changed so as to appear before the term "wherein.

All other claims depend directly or indirectly from rejected claims and are, therefore, also rejected under USC 112, second paragraph for the reasons set forth above.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 19, 21, 23, 31, and 33-49 (as instantly amended and/or added) are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,929,808. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed product-by-process (i.e., an *Uncaria* extract composition as prepared by the instantly recited steps) employs the same or similar process steps as those recited in the '808 process claims.

Please note that although the Bibliographic data provided by Applicants state that the instant Application is a Divisional Application of US Patent No. 6,929,808, the instantly claimed invention is deemed to reasonably read upon the claimed '808 invention with respect to the obviousness-type double patenting rejection above (i.e., no restriction requirement was made in the parent Application in terms restricting the preparatory method from the product produced thereby - including, e.g., the products defined by the instant product-by-process claims, as amended within the 22 December 2006 response).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

No claim is allowed (please see Interview Summary attached hereto).

If Applicants are aware of any Patents or copending Patent Applications that reasonably read upon the instantly claimed invention - with respect to potential obviousness-type double patenting rejection(s), it is requested that they be made of record and that Applicants file an appropriate Terminal Disclosure over such patents and/or Applications (to hasten prosecution).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (571) 272-0970. The examiner can normally be reached on Mon-Thur, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher R. Tate
Primary Examiner
Art Unit 1655